REMARKS/ARGUMENTS

Favorable reconsideration of this application, in light of the following discussion is respectfully requested.

Claims 1-21 are pending in this application. No claim amendments are presented, thus, no new matter is added.

In the outstanding Office Action, Claims 1-21 were rejected under 35 U.S.C. 102(e) as being anticipated by Foladare et al (U.S. Patent No. 5,905,777, herein "Foladare"). Applicants respectfully traverse this rejection.

Independent Claim 1 recites, A device in a communication network having multiple sub-networks, where each of the sub-networks includes services that may be different from that of other sub-networks, comprising:

> an information processor configured to receive a service request message from a first sub-network, said service-request message including information on a service to be executed, said information processor configured to identify the service; and
> an information database connected to said information processor, said information database configured to identify the different services associated with the sub-networks, *the different services including protocol translations required to provide the requested service*, that are accessible as part of the network, wherein
> said information processor is further configured to retrieve sub-networks available to provide the requested *service based on the different services identified from the database*, and initiate a message to establish a communication link with at least one of the identified services that are capable of providing the service.

Independent Claim 11, while directed to an alternative embodiment, recited substantially similar features. Accordingly, the remarks presented below are applicable to each of independent Claims 1 and 11.

2

Turning to the applied reference, Foladare discloses a communication system including an E-mail server and an E-mail network, in which useful E-Mail messages can be identified, separated from junk mail, and forwarded as directed by the recipient.[1]

Foladare, however, fails to teach or suggest an information database configured to identify the different services associated with the sub-networks, *the different services including protocol translations required to provide the requested service*, ... wherein the information processor is further configured to retrieve sub-networks available to provide the requested service *based on the different services identified from the database*, as recited in independent Claim 1.

The Office Action indicates that Applicants' previously filed remarks, concerning the protocol translations recited in independent Claim 1, were not persuasive because, with respect to Foladare, it is "inherent to have protocol translations in order to provide for a data message from a computer to be translated for a fax, pager..."

However, as noted above, independent Claim 1 is not directed only to protocol translation, but further recites a specific relationship between an information database configured to identify the different services associated with the sub-networks, *the different services including protocol translations required to provide the requested service*, ... and the information processor which is further configured to retrieve sub-networks available to provide the requested service *based on the different services identified from the database*. Thus, the protocol translation services are identified in the database, then the information processor retrieves a sub-network available to provide the translation based on the database information.

In contrast, Foladare describes that the E-Mail server receives an E-Mail message and then accesses the recipient's record from the database 62.[2] In addition, Foladare's step 406

---

[1] See Foladare in the Abstract.

determines if the sender ID 233 in the received message 239 matches any of the senders in the sender list 252 of the recipient's record.[3] Thus, the information stored in the database 62 of Foladare does not identify different services associated with the sub-networks, with each service *including protocol translations required to provide the requested service*, as recited in independent Claim 1. Specifically, the database of Foladare does not identify protocol translation services, whatsoever. Instead, the database of Foladare simply stores user profile information, which can <u>not</u> reasonably considered as data that identifies a protocol translation service associated with a sub-network.

Further, "[i]n relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonable support the determination of the allegedly inherent characteristic <u>necessarily</u> flow from the teachings of the applied prior art." *See* <u>Ex parte Levy</u>, 17 USPQ2d 1461, at 1464 (Bd. Pat. App. & Inter. 1990) and M.P.E.P. § 2112.

As discussed above, simply because the device of Foladare may be capable of sending messages to facsimile or printing devices, it does not <u>necessarily</u> follow from these teachings that Foladare includes a database identifying different services associated with the sub-networks, each service *including protocol translations required to provide the requested service*, as recited in independent Claim 1.

Independent Claim 1 further recites that "the information processor is further configured to retrieve sub-networks available to provide the requested service *based on the different services identified from the database.*"

In addressing this claimed feature, the Official Action cites Fig. 1 of Foladare. However, Fig. 1 simply shows a conventional network structure, and does not teach or suggest retrieving sub-networks available to provide the requested service *based on the*

---

[2] See Foladare at column 4, lines 55-64, and in Figures 2 and 4.
[3] See Foladare from column 4, line 65 to column 5, line 10.

4

different services identified from the database, as recited in independent Claim 1. As noted above, the Official Action relies on database 62 of <u>Foladare</u> to address the database feature recited in the claims. <u>Foldare's</u> database, however, simply stores user profile and forwarding information, and does not facilitate retrieving sub-networks available to provide the requested service *based on the different services identified from the database*, as recited in independent Claim 1.
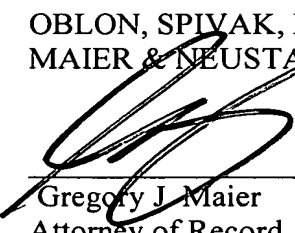
Therefore, the applied reference fails to teach or suggest every feature recited in Applicants' claims, so that Claims 1-3, 5-14 and 16-21 are patentably distinct over <u>Foladare</u>. Accordingly, Applicants respectfully traverse, and request reconsideration of, the rejection based on <u>Foladare</u>.

Consequently, in view of the present Amendment, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal Allowance. A Notice of Allowance for Claims 1-3, 5-14 and 16-21 is earnestly solicited.

Should the Examiner deem that any further action is necessary to place this application in even better form for allowance, the Examiner is encouraged to contact Applicants' undersigned representative at the below listed telephone number.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Gregory J. Maier
Attorney of Record
Registration No. 25,599

Customer Number

22850

Tel: (703) 413-3000
Fax: (703) 413-2220
(OSMMN 06/04)

Andrew T. Harry
Registration No. 56,959

I:\ATTY\ATH\PROSECUTION\21's\215236US\215236US-AMENDMENT DUE 10.20.06.DOC